1. The examiner acknowledges the cancellation of claims 1-9, the amendments to claims 10-12, and the addition of claim 13 filed on Dec. 1, 2009. Claims 10-13 are pending.

2. The examiner notes that the "Listing of claims" filed on Dec. 1, 2009, does not comply with 37 CFR 1.121. New claim 13 includes markings. According to 37 CFR 1.121(c)(3), "[a]ny claim added by amendment must be indicated with the status of 'new' and presented in clean version, *i.e.*, without any underlining."

However, in the interest of compact prosecution, the "Listing of claims" in the "Amendment to the claims" section filed on Dec. 1, 2009, has been entered and replaces all prior versions and listings of claims in the instant application.

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

(1) The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 602.

The inventors should be swearing to "the specification of which was filed as PCT international application PCT/US2004/026191 on 12 August 2004," not to the specification filed on 13 February 2006 as United States Application 10/568,039.

(2) The benefit of priority claimed to PCT/US2004/026191 under 35 U.S.C. 119 is incorrect.

This application is the national stage of the PCT application PCT/US2004/026191 filed under 35 U.S.C. 371: it is therefore a continuation of the prosecution of the application PCT/US2004/026191. There is no basis in 35 U.S.C. 119 for a claim for priority based on the PCT application.

In the response filed on Dec. 1, 2009, applicants state that a "newly executed oath will be submitted in the future upon the obtaining the signatures of the inventors. However, a new oath has not been filed at the preparation of this office action. According, the objection to the oath stands.

4. The objection to the specification set forth in the office action mailed on Sep. 2, 2009, paragraph 4, has been mooted by the cancellation of claim 5 filed on Dec. 1, 2009.

The rejections of claims 1-5 and 10-12 under 35 U.S.C. 112, second paragraph, set forth in the office action mailed on

Sep. 2, 2009, paragraph 6, have been withdrawn in response to the cancellation of claim 1 and the amendment to claims 10-12 filed on Dec. 1, 2009.

The objections to claims 6 and 7 set forth in the office action mailed on Sep. 2, 2009, paragraph 7, have been mooted by the cancellation of claims 6 and 7 filed on Dec. 1, 2009.

The rejections of claims 1, 4, 5, 7, 9, and 10 under 35 U.S.C. 102(e) over US 6,640,715 B1 (Watson); of claims 1-11 under 35 U.S.C. 102(b) over WO 00/79346 A1 (Levy)("corrected version"); of claims 1, 4, 7, 9, and 10 under 35 U.S.C. 102(b) over European Patent 1,002,840 A1 (Moreland); of claims 1-3, 6, 8, and 10 under 35 U.S.C. 102(b) over Japanese Patent 06-295092 (JP'092), set forth in the office action mailed on Sep. 2, 2009, paragraphs 12-15, respectively, have been withdrawn in response to the cancellation of claims 1-9 and the amendment to claim 10 filed on Dec. 1, 2009. That amendment to claim 10 adds the limitation that the printing machine comprises a first printing unit, a fuser mechanism (13) for fixing a toner-based printing format on a medium formed by the first printing unit, and a second printing unit located downstream from the fuser mechanism, which includes an ink containing an aromatic substance. Neither Watson, Levy, Moreland, nor JP'092 teaches a printing machine as recited in instant claims.

5. In light of the disclosure in the instant specification, the examiner has interpreted the term "aromatic substance" recited in instant claims as any substance that smells, i.e., that has an aroma, smelling sweet or spicy, fragrant or pungent, etc. See the disclosure in the instant specification at page 5, lines 1-7, which states "[w]hile not intended to be all-inclusive, the following represents a list of possible aromatic substances that can added to a toner: Lemon oil, clove, geranium, lavender . . . cat food, dog food . . . or the like. There are, in fact, no limits with respect to the aromatic substance that may be used."

Rejections based on this interpretation are set forth infra.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,535,713 B2 (Richards) combined with WO 00/79346 A1 (Levy) ("corrected version").

Richards discloses a printing apparatus for controlling gloss. Col. 4, lines 6-8. The apparatus comprises an

electrophotographic toner printing unit **400** for forming a colored toner image on a substrate and a clear application unit **406** that applies a clear toner over the colored toner image. The clear application unit **406** may be an electrophotographic toner printing unit or an inkjet (piezoelectric or thermal) printing unit, and the clear toner may be a solid or a liquid. The printing unit **400** may comprise more than one color toner printing unit. Fig. 1b and col. 9, lines 1-24. According to Richards, the clear toner may be applied to an unfixed or fixed colored toner image. Col. 4, lines 9-13. Richards teaches that the clear application unit may be placed after the fuser or fixer that fixes the color toner image to the substrate. Col. 5, lines 51-53, and Fig. 3. Fig. 3 shows a printing apparatus comprising the clear toner application unit **200** after the fuser.

Thus, when the clear application unit **406** is an inkjet unit, the Richards printing apparatus meets the limitations of the apparatus recited in instant claims 10-13, but for the presence of an ink comprising an aromatic substance.

Richards does not limit the composition of the inks used in the inkjet unit in the printing apparatus.

Levy teaches that a fragrance agent may be added to non-colored inkjet inks. Page 1, lines 1-10; page 5, lines 29-31;

page 7, lines 19-24; and page 8, lines 3-8. In inkjet inks, the fragrance agent may be present as microparticles or in soluble form in the carrier solvent. Page 7, lines 19-24. According to Levy, the fragrant non-colored inkjet ink provides a fragrant printed article. Page 4, lines 1-14; page 8, lines 3-8 and 16-18; and Fig. 2. Levy further teaches that fragrant non-colored inkjet ink images may overlap a portion or all of the printed colored toner images. Page 8, lines 22-25.

It would have been obvious for a person having ordinary skill in the art, in view of the teachings of Levy, to incorporate a fragrance agent in the clear inkjet liquid toner ink, as taught by Levy, in the printing apparatus disclosed by Richards comprising the clear inkjet application unit. That person would have had a reasonable expectation of successfully obtaining a printing apparatus that provides fragrant glossy colored printed media.

Applicants' arguments filed on Dec. 1, 2009, have been fully considered but they are not persuasive.

Applicants assert that applicants' invention "is not, in any manner, anticipated or taught by the cited prior art alone or in any combination." Applicants further assert certain benefits of the claimed apparatus, e.g., "specially allows simple and cost effective 'personalization of aroma' of high

quality toner based printed products separated from the toner image," "the kind of smell specifically desired can be readily changed simple and fast sequence," etc.

Applicants' assertions are not persuasive for the reasons given in the rejection supra. The alleged benefits do not correspond to claim limitations that distinguish over the prior art.

Accordingly, the rejection of claims 10-13 stands.

8. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Sandra Sewell, whose telephone number is (571) 272-1047.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Janis L. Dote/
Primary Examiner, Art Unit 1795

JLD
Jan. 11, 2010